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DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: GARY JOHN COREY)
Application No.: 10/079,309)
Filed: February 21, 2002) **DECISION ON PETITION TO**
For: **MULTI-AXES TOOL**) **WITHDRAW THE HOLDING OF**
COMPENSATION: 3D AND 5-AXIS REAL-) **ABANDONMENT**
TIME INTERACTIVE TOOL)
COMPENSATION INSIDE THE CNC)
MACHINE TOOL CONTROLLER)

This is in reply to Petitioner's communication, filed in the United States Patent and Trademark Office on January 02, 2004. This communication will be treated as a petition to Withdraw the Holding of Abandonment under 37 CFR 1.181 for the purpose of this decision. No fee is required.

The Petition is **GRANTED**.

BACKGROUND

A review of the file record reveals that:

1. The Examiner, on February 21, 2003, issued a first Office Action.
2. Petitioner, a *pro se* applicant, on May 08, 2003, timely submitted an amendment after non-final Office Action which included a substitute specification.
3. The Examiner, on June 10, 2003, did not enter the substitute specification because it failed to comply with 37 CFR 1.125(b), and issued a final Office Action.
4. The Petitioner, on August 12, 2003, submitted an amendment after final Office Action.
5. The Examiner did not enter Petitioner's amendment after final Office Action, and issued an Advisory Action on August 27, 2003.
6. The Petitioner, on November 12, 2003, submitted a second amendment after final Office Action, which was not entered.
7. The application was held abandoned on December 11, 2003.
8. Petitioner, on January 02, 2004, petitioned to Withdraw the Holding of Abandonment under 37 CFR 1.181.

OPINION

The relevant portions of the Manual of Patent Examining Procedure (MPEP) are reproduced as follows:

MPEP 714.03.

...

If an amendment submitted after March 1, 2001, fails to comply with 37 CFR 1.121 (as revised on September 8, 2000), the Office will notify applicant by a Notice of Non-Compliant Amendment, that the amendment fails to comply with the requirements of 37 CFR 1.121 and applicant will be given a period of time in which to comply with the rule.

...

Where the amendment is *bona fide* but contains a serious omission, the examiner should: A) if there is sufficient time remaining for applicant's reply to be filed within the time period for reply to the non-final Office action (or within any extension pursuant to 37 CFR 1.136(a)), notify applicant that the omission must be supplied within the time period for reply; or B) if there is insufficient time remaining, issue an Office action setting a 1-month time period to complete the reply pursuant to 37 CFR 1.135(c). In either event, the examiner should not further examine the application on its merits unless and until the omission is timely supplied.

If a new time period for reply is set pursuant to 37 CFR 1.135(c), applicant must supply the omission within this new time period for reply (or any extensions under 37 CFR 1.136(a) thereof) in order to avoid abandonment of the application. The applicant, however, may file a continuing application during this period (in addition or as an alternative to supplying the omission), and may also file any further reply as permitted under 37 CFR 1.111.

Where there is sufficient time remaining in the period for reply (including extensions under 37 CFR 1.136(a)), the applicant may simply be notified that the omission must be supplied within the remaining time period for reply.

Petitioner's amendment after non-final Office Action filed May 08, 2003 contained serious omissions. There were no Petitioner's rebuttal evidence and arguments concerning the Examiner's grounds of rejection. And the amendment failed to comply with 37 CFR 1.121(c). As a result, Petitioner's amendment should have been construed either as one which was not fully responsive, or as a *bona fide* attempt which contained a serious omission. In either case, according to MPEP 714.03, Petitioner should have been given a period of time in which to comply with the rule. Instead, the Examiner issued a final Office Action. The Examiner stated that "the substitute specification filed on 5/8/03 has not been entered" and "the amendment to the claims filed on 5/8/03 does not comply with the requirements of 37 CFR 1.121(c)." The final Office Action contained no new ground of rejection or any reference to the ground of rejection of the previous non-final Office Action. Consequently, the final Office Action June 10, 2003 was premature.

Since Petitioner is a *pro se* applicant, the amendment after non-final Office Action dated May 08, 2003, is not fully responsive, and Examiner's final Office Action dated June 10, 2003 is premature, the holding of abandonment dated December 11, 2003 is hereby withdrawn and the final Office Action dated June 10, 2003 is vacated.

The application will be forwarded to the Examiner of Record to issue a Notice of Non-Compliant Amendment or a non-final Office Action. The Examiner will notify Petitioner that the amendment after non-final Office Action dated May 08, 2003 fails to comply with the requirements of 37 CFR 1.121. Petitioner will be given a TIME PERIOD of ONE MONTH or THIRTY DAYS from the mailing of the Notice of Non-Compliant Amendment or the non-final Office Action, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

It is noted that Petitioner is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Petitioner is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Petitioner is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.



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